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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,704	02/26/2001	Matthias Witschel	49365	9140

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EXAMINER

ROBINSON, BINTA M

ART UNIT PAPER NUMBER

1625

DATE MAILED: 09/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,704

Applicant(s)

WITSCHER ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Detailed Action

The 35 U. S. C. 101 rejection of claim 25 is withdrawn in light of applicant's amendment at paper no 12/C as well as the 35 U. S. C. 112, second paragraph rejections of claims the phrase "where the four last-mentioned radicals may be partially or fully halogenated and/or may carry one to three of the following substituents" in claims 1-25, the phrase "at least one" in claim 22,

(old rejections)

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 22 and 23 in part are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 22 in part is indefinite for being improper product use claims. Applicant is referred to *Clinical Products v. Brenner* -Commissioner of Patents) 149 USPQ 475 (District Court DC 66) *Ex parte Dunki* 153 USPQ 678 (Bd of Appeals 1967).


B. Claim 23 recites the limitation "A process for preparing compositions as claimed in claim 22" in line 1. There is insufficient antecedent basis for this limitation in the claim.

(new rejections)

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

 Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not provide enablement for 2 to 3 cyanos, nitros or other electron withdrawing groups on R1 equal to phenoxy in the ortho position, R1 equal to all heterocycloxy, or heterocyclithio, R5 equaling N-linked heterocyclyl or O-(N-linked heterocyclyl), it being possible for the heterocyclyl radical of the two last-mentioned substituents to be partially or fully halogenated and/or to carry one to three of the following radicals: nitro, cyano, C1-C4-alkyl, C1-C4-haloalkyl, C1-C4-alkoxy or C1-C4-haloalkoxy, R7 equaling heterocyclyl, heterocyclyl-C1-C6-alkyl, heterocyclylcarbonyl-C1-C6-alkyl, heterocyclylcarbonyl, heterocyclylaminocarbonyl, N-(C1-6-alkyl)-N-(heterocyclyl)aminocarbonyl, heterocyclyl-C2-C6-alkenylcarbonyl, it being possible for these radicals to be partially or fully halogenated and/or to carry one to three of the substituents claimed, R8 and R9 equal to all heterocyclyl, heterocyclyl-C1-C6-alkyl, heterocycloxy, it being possible for these radicals to be substituted as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims as recited are broader than the scope of enablement. The specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. The applicant is referred to *In re Wands*, 858 f.2d 731, 737, 8

USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the incorporation of the 8 factors recited in Ex parte Foreman 230 USPQ 546 (Bd. Of App. And Inter 1986).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art 6) the amount of direction provided by the inventor 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F. 2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

In terms of the first Wands factor of breadth, R1, R5, R7, R8, and R9 encompass a much wider Markush grouping of radicals than those radicals tested and synthesize 2) the nature of the invention is that these compounds are useful for controlling undesirable plants as described. In terms of the fifth Wands factor, the level of predictability in the art is low since none of the actual data values for activity against harmful plants was disclosed in the specification. In terms of the sixth Wands factor, the amount of direction provided by the inventor is poor, because the applicant does not disclose actual data values for activity against harmful plants was disclosed in the specification. Additionally, the applicant does not test the whole breadth of compounds encompassing all of the moieties that these particular radicals can be.

In terms of the 8th Wands factors, undue experimentation would be required to


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make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of predictability in the art of the invention, and the poor amount of direction provided by the inventor. Taking the above factors into consideration, it is not seen where the instant claim is enabled by the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.


CEIL CHANG
PRIMARY EXAMINER, Act: 8 SPE
GROUP 1200 625

Binta Robinson

September 1, 2002